



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,192	03/29/2001	William G. Moon	Q01-1052-US1	7305

7590 12/02/2003

ROBERT A. SALTZBERG
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105

EXAMINER

LEE, CHRISTOPHER E

ART UNIT	PAPER NUMBER
----------	--------------

2189

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,192

Applicant(s)

MOON ET AL.

Examiner

Christopher E. Lee

Art Unit

2189

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Group I. Claims 1-14, drawn to a hard disk drive based data archive system emulating a tape archive system, classified in class 361, subclass 685.
- Group II. Claims 15 and 16, drawn to a data storage box for connection to a host computing system via a universal serial bus structure, classified in class 710, subclass 313.
- Group III. Claims 17-20, drawn to a data storage box for connection to a host computing system via an internet network connection in accordance with the internet TCP/IP interface, classified in class 709, subclass 250.
- Group IV. Claims 21-33, drawn to a hard disk drive data archive system for emulating electrically a tape library including a multiplicity of tape cartridges each having a predetermined storage capacity, classified in class 711, subclass 4.
- Group V. Claims 34 and 35, drawn to a method for testing data-archive functionality of a rotating hard disk drive holding user archive data within an archive array of rotating hard disk drives, classified in class 714, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as in systems which do not have a data storage box for connection to a host computing system via a universal serial bus structure or an internet network connection in accordance with the internet TCP/IP interface, in systems which do

not have a hard disk drive data archive system for emulating electrically a tape library including a multiplicity of tape cartridges each having a predetermined storage capacity, and in systems which do not have a method for testing data-archive functionality of a rotating hard disk drive holding user archive data within an archive array of rotating hard disk drives. See MPEP § 806.05(d).

3. Inventions Group II and Group III-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as in systems which do not have a data storage box for connection to a host computing system an internet network connection in accordance with the internet TCP/IP interface, in systems which do not have a hard disk drive data archive system for emulating electrically a tape library including a multiplicity of tape cartridges each having a predetermined storage capacity, and in systems which do not have a method for testing data-archive functionality of a rotating hard disk drive holding user archive data within an archive array of rotating hard disk drives. See MPEP § 806.05(d).

4. Inventions Group III and Group IV-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group III has separate utility such as in systems which do not have a hard disk drive data archive system for emulating electrically a tape library including a multiplicity of tape cartridges each having a predetermined storage capacity, and in systems which do not have a method for testing data-archive functionality of a rotating hard disk drive holding user archive data within an archive array of rotating hard disk drives. See MPEP § 806.05(d).

5. Inventions Group IV and Group V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group IV has separate utility such as in systems which do

not have a method for testing data-archive functionality of a rotating hard disk drive holding user archive data within an archive array of rotating hard disk drives. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-V, the search required for Group II is not required for Group III-V, the search required for Group III is not required for Group IV-V, and the search required for Group IV is not required for Group V, restriction for examination purposes as indicated is proper.

8. A telephone call was made to Mr. Robert A. Saltzberg (Reg. No. 36,910) on 25th of November 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

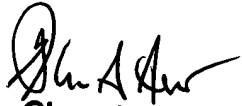
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E. Lee whose telephone number is 703-305-5950. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on 703-305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Christopher E. Lee
Examiner
Art Unit 2189

cel/ *CEL*


Glenn A. Auve
Primary Patent Examiner
Technology Center 2100